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IN THE

Supreme Court of the United States

FESTO CORPORATION,

Petitioner,

v.

SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD., A/K/A SMC CORPORATION AND SMC PNEUMATICS, INC.,

Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICUS CURIAE VINCENT P. TASSINARI IN SUPPORT OF NEITHER PARTY

VINCENT P. TASSINARI
Counsel of Record
Attorney for Amicus
3232 N. Halsted St., #D908
Chicago, IL 60657-3476
(773) 472-0316

Midwest Law Printing Company/Photex - Chicago - (312) 321-0220

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INTEREST OF AMICUS CURIAE[1]

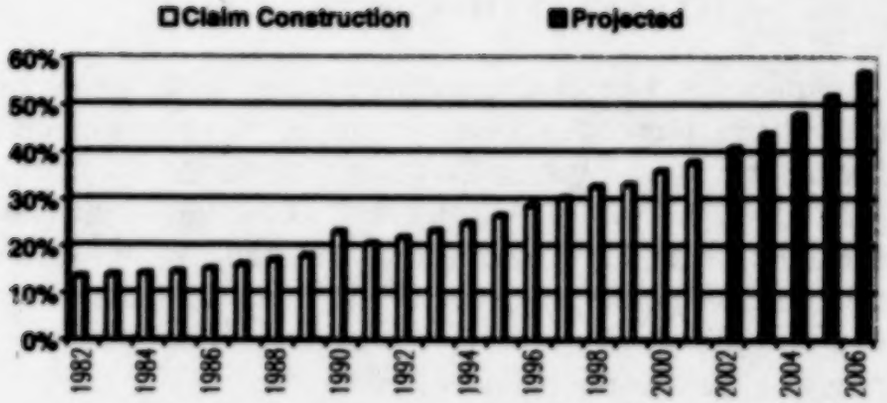
Amicus is a practicing patent attorney who creates on a daily basis prosecution history similar to the prosecution history that now is before the Court. Moreover, Amicus has been directly involved in written exchanges with patent examiners that have resulted in hundreds of prosecution histories. Accordingly, Amicus and those similarly situated will be directly responsible for implementing this Court's ruling on the doctrine of equivalents.

Amicus perceives the lower court's holding is an attempt to curb the rise in patent claim construction litigation. In 1982, the year in which the Court of Appeals for the Federal Circuit was formed, approximately 13.5% of the Federal Circuit's patent opinions addressed patent claim construction issues. Over the next nineteen years, the amount of time that the Federal Circuit has devoted to patent claim construction issues has increased to approximately 38%. As seen in the following chart,[2] this increase itself is experiencing an increase such that Amicus estimates that by the year 2005, over 50% of the Federal Circuit's time addressing patent issues will be devoted to patent claim construction.

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[1] The written consent of all parties to file this brief has been filed with the Court Clerk. Only the attorney for Amicus authored this brief. Other than Amicus, no person or entity made a monetary contribution to the preparation or submission of this brief. The views contained in this brief are those of Amicus only and may not represent the views of the law firm of the attorney for Amicus or clients of the attorney for Amicus.

[2] Data obtained for each year by dividing the number of Federal Circuit opinions referencing "claim construction" and "patent" with number of Federal Circuit's opinions referencing "patent."



A central reason as to why claim construction has become so prominent on the Federal Circuit's docket is the role claim construction has come to play in a patent infringement lawsuit. Without qualification, it is fair to say that a significant number of infringement cases come down to a dispute over the meaning of a claim term. Simply put, whichever party's definition of the claim term at issue is adopted by the court wins the litigation.

Under the view of Amicus, the lower court sought to curb the tide of claim construction litigation by improperly expanding the actions that give rise to prosecution history estoppel in a fractured opinion that is inconsistent with the directions of *Warner-Jenkinson*. Amicus believes that a way to curb the tide of claim construction litigation is to significantly restrict the use of extrinsic evidence (for example, expert testimony, dictionary definitions, and learned treatises) in claim construction.

Through this brief, Amicus suggests a resolution of the appealed doctrine of equivalents issue that is consistent with the Court's holding in *Warner-Jenkinson* and that may be used as part of an overview of patent claim construction.

SUMMARY OF ARGUMENT

Litigation over the meaning of a patent claim term increasingly is engulfing the lower courts, particularly the Federal Circuit. This case presents the Court with an opportunity to decrease future litigation by issuing a holding on prosecution history estoppel where that holding is placed within the context of an overview of patent claim construction. In particular, the Court may use this case as a vehicle to provide clearer guidance on patent claim construction as a whole.

A. Prosecution History Estoppel

In regards to a holding on prosecution history estoppel, Amicus proposes that the Court reverse the holding of the lower court by allocating the Court's burden-shifting holding of *Warner-Jenkinson* between a patent holder and an alleged infringer. Thus, Amicus proposes the following:

In the absence of a reason for a claim amendment required by the PTO under 35 U.S.C. §§ 102, 103 during patent prosecution, the burden is on the patent holder to establish a reason for the claim amendment by a preponderance of the evidence at the time of issue. In the absence of a reason for a claim amendment not required by the PTO under 35 U.S.C. §§ 102, 103 during patent prosecution, the burden is on the alleged infringer to establish a reason for the claim amendment by a preponderance of the evidence at the time of infringement.

The reason for the claim amendment at issue must be related directly to the patentee giving up § 112(a) scope of the § 112(b) subject matter in response to the requirements under either 35 U.S.C. § 102 or 35 U.S.C. § 103 and in exchange for a patent grant.

As set out in detail below, the court then would, as appropriate, determine whether the position of the patent holder is to be restricted by 35 U.S.C. § 132(a) prosecution history estoppel.

The described § 132(a)[3] prosecution history estoppel in this brief gives proper deference to the role of the § 154 patent document and § 132(a) prosecution history in both establishing the property rights of a patent holder and in providing public notice. Moreover, proper deference is given to the primacy of the PTO in ensuring that the claims allowed cover only the § 112(b) subject matter that is properly patentable in a proffered patent application. Applied in this fashion, § 132(a) prosecution history estoppel places § 112(a) doctrine of equivalents within the structure of the Patent Act and places reasonable limits on the doctrine.

B. Overview of patent claim construction

Regarding an overview of patent claim construction, Amicus proposes that the Court define intrinsic evidence as evidence within the § 154 patent document and the § 132(a) prosecution history as well as that which can be logically inferred from this evidence. Extrinsic evidence is evidence that is external to the § 154 patent document and the § 132(a) prosecution history. Only intrinsic evidence may be used to give legal meaning to the terms in a patent claim. Extrinsic evidence at most shall only be used as a court-aid to linguistically understand the terms used in a patent.

The above rules prevent plaintiff and defense patent litigation attorneys from elevating linguistic extrinsic evidence

[3] All section numbers in this brief refer to Title 35, United States Code, unless otherwise noted.

to intrinsic legal meaning within a patent through expert testimony, dictionary definitions, and learned treatises. In turn, this will compel those who prepare patent applications to include more detailed description on each claim term as of the date of filing that application. At present, accused infringers are subject to the rule that inventors have the right to be their own lexicographer. Under the above holding, inventors would have a duty to be their own lexicographer or else suffer a loss of scope of the claimed subject matter.

ARGUMENT

In general, a 35 U.S.C. § 154 patent document carries with it a written description and at least one claim as part of a specification. The requirements for the specification are set out in 35 U.S.C. § 112.

In practice, referencing to § 112 is made difficult by the lack of section markers in that statute. The adopted section markers (a)(1), (a)(2), (a)(3), (b), etc. for § 112 would make future reference to the sections of this statute clearer. For the purpose of this brief, the relevant sections of § 112 are delineated in part, made gender neutral, and textually modified for clarity as follows:

[35 U.S.C. § 112 compiled on next page for clarity]

35 U.S.C. § 112. Specification (as modified by Amicus)

(a) The scope of the claimed subject matter

(1) Description

The specification shall contain a written description of the invention.

(2) Enablement

The specification shall contain a written description of the manner and process of making and using the invention, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention.

(3) Best mode

The specification shall set forth the best mode contemplated by the inventor of carrying out the invention.

(b) The claimed subject matter

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as the claimed invention.

...

(f) Means/Step plus function

(1) Without the recital of structure, material, or acts, a term in a claim for a combination under subsection (b) may be expressed as a **(A)** means for performing a specified function or **(B)** step for performing a specified function.

(2) A claim term under subsection (f)(1) shall be construed to cover **(A)** the corresponding structure, material, or acts described in the specification and **(B)** the equivalents of the corresponding structure, material, or acts described in the specification.

I. APPROACH TO PATENT CLAIM CONSTRUCTION

A. Rules of Structure: Subject Matter and Scope

In general, an invention patent claim is a group of claim terms tangibly fixed as a unit in a government-issued, legal document that particularly and distinctly recites the 35 U.S.C. § 112(b) subject matter that the inventor regards as the claimed invention. Each claim term may include one or more words.

All words have at least one linguistic meaning. Thus, the words used to convey claim terms incidentally have at least one linguistic meaning. However, this linguistic meaning of the claim words does not determine the federal property rights of the inventor. Rather, it is the legal meaning given to a claim term by the inventor that determines the federal property rights of the inventor. As articulated in a lower court decision:

> Courts must exercise caution lest dictionary definitions, usually the least controversial source of extrinsic evidence, be converted into technical terms of art having legal, not linguistic, significance.[4]

Consistent with this, federal law under § 112 puts the burden on the inventor to establish the legal meaning of a patent claim term within the patent document as of the time of filing the patent application. To understand how an individual preparing a patent application achieves this, it is important to understand how the Patent Act structurally sets out the requirements for the legal meaning of a patent claim term.

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[4] *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1478 (Fed. Cir. 1998).

It is a proposition of this brief that Congress divided the meaning of a patent claim term into two subsections. A first portion is under § 112(b). The remaining portion is under § 112(a). Here, the legal meaning of a patent claim term divides into the subject matter of that claim term and the scope of that subject matter, namely:

- meaning = subject matter + scope of subject matter.[5]

As textually expressed in § 112(b), only the subject matter of a claim term is to be placed within the claims. Accordingly, the scope of the § 112(b) subject matter must reside somewhere else. Although not textually expressed, case law after case law has resorted to the parts of the patent document disclosed under § 112(a) to derive the scope of a patent claim term. Accordingly, the Patent Act structurally divides the legal meaning of a patent claim term into the § 112(b) subject matter of that claim term and the § 112(a) scope of the subject matter of that claim term.

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[5] Other concepts to this proposed overall approach are as follows:

- the doctrine of equivalents is included as part of § 112(a);
- prosecution history estoppel is under 35 U.S.C. § 132(a) (*See Bose Corp. v. JBL, Inc.*, 98 F.Supp.2d 80, 90 (D.Mass. 2000);
- § 132(a) prosecution history estoppel operates on *both* the literal scope and doctrine of equivalents scope of § 112(a);
- § 112(a) doctrine of equivalents scope applies to § 112(f)(2)(B) means/step plus function equivalents; and
- § 132(a) prosecution history estoppel applies to § 112(f)(2)(B) means/step plus function equivalents through § 112(a) doctrine of equivalents scope.

After exhaustive research, Amicus has not found the following view articulated: (i) that § 112(a) sets out the scope requirement of patent claim term meaning and (ii) that the § 112(b) subject matter of a claim term is insufficient by itself to determine patent claim term meaning. This view does, however, provide a core basis from which an overview of patent claim construction may be developed. For example, a current goal of patent claim construction imprecisely asks "what is the scope and meaning of each claim limitation?". However, it is more precise to ask "what scope did the inventor give the subject matter of each claim term?". Moreover, in view of the claim term by claim term approach to patent infringement, a more workable approach to analyzing each claim term would be to determine "whether an element of the accused device is within or without the § 112(a) scope of the § 112(b) subject matter of the claim term."

Dividing patent claim term meaning into subject matter and scope of subject matter provides other techniques to gain insight into patent claim construction. For example, the § 112(b) subject matter representing one claim term and the § 112(a) scope of that subject matter as originally filed may be visualized as in Figure 1:

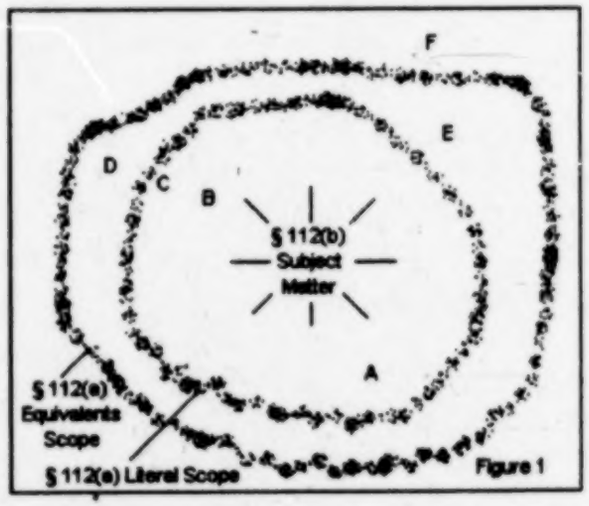


Figure 1

In the above figure, A, B, C, D, E, and F represent accused infringer elements, each positioned with respect to the § 112(a) scope. The above figure illustrates that the § 112(b) subject matter of a claim term by itself has no scope in its capacity as a member of a claim. This is consistent with the requirement that only the § 112(b) subject matter be placed within the claims. What truly sets the boundary of an inventor's federally protected property is the § 112(a) scope. While the § 112(b) subject matter may locate the subdivision of a claim term, it is the collective of the § 112(a)(1) description, § 112(a)(2) enablement, and § 112(a)(3) best mode requirements that provide the public notice of a lot boundary within which they may not enter without permission.

Importantly, the § 112(a) scope of an issued claim term is at its maximum on the filing date of its associated patent application. At that point in time, the inventor has articulated the § 112(a) literal scope of each claim term through the collective use of that term within the patent document, including the § 112(a)(1) description provided by the claims, abstract, title, background, figures, and detailed description section. Also as of the filing date, the scope of the doctrine of equivalents under § 112(a) is set as a function of the § 112(a) literal scope. This is to say, the degree to which the patent application drafter literally describes a claim term within the patent document provides the datum from which the § 112(a) equivalents scope may be referenced. Thus, even though the § 112(a) equivalents scope is not literally articulated within the patent document at the time of filing, the § 112(a) equivalents scope is a boundary to which the inventor is entitled (at least as of the time of filing).

It is well known that, with regard to a patent claim term, any unimportant and insubstantial change that is in existence as of the filing date or comes into existence after the filing

date of a patent application is included within the § 112(a) equivalents scope of that claim term for the life of the patent. To achieve this, § 112(a) doctrine of equivalents scope is evaluated at the time of infringement rather than measured at the time the patent was filed or was issued. *Warner-Jenkinson*, 520 U.S. at 37. Since the § 112(a) equivalents scope is set as a function of the § 112(a) literal scope as of the filing date of the issued patent, its subsequent evaluation at the time of infringement does not add additional § 112(a) scope to the § 112(b) subject matter after the filing date.

B. Rules of Evidence: Intrinsic and Extrinsic

With the above § 112(a) and § 112(b) structure in mind, it is important to have rules of evidence to bring evidence to or keep evidence from the legal meaning of a patent claim term. From those lines of cases that depend from *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed. Cir. 1996), there appears to be a general consensus that the legal meaning of a patent claim term is derived through intrinsic evidence. To put it another way, intrinsic evidence is evidence that establishes the legal meaning of a claim term. However, case law is not clear as to what constitutes intrinsic evidence.

It is a proposition of this brief that intrinsic evidence is limited to the claims, the written and illustrative description, and any timely, relevant statements made by the patentee during prosecution. Under this proposed rule, intrinsic evidence is evidence within the § 154 patent document and the timely, relevant § 132(a) prosecution history as well as that which can be logically inferred from these documents.

It also is a proposition of this brief that extrinsic evidence be defined as evidence that is to be excluded from the legal meaning of a claim term. Extrinsic evidence is evidence that is not included in the claims, written specification, illustrative

specification, and timely, relevant statements made by the patentee during prosecution. Extrinsic evidence includes expert testimony and dictionary definitions. Under this proposed rule, extrinsic evidence is evidence that is external to the § 154 patent document and the § 132(a) prosecution history.

The Federal Circuit has summed up the significance of extrinsic evidence, as follows:

> [t]he claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention. Allowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless.

Vitronics Corp., 90 F.3d at 1583 (citation omitted).

Under present patent practice, it is said that claim terms are to be given their ordinary and customary meaning as understood by one of ordinary skill in the art. *Id.* at 1582. Under this approach, the world appears as a bed of an unlimited number of oysters from which a patentee and alleged infringer may pick and choose evidence to give meaning to a claim term. Overtime, giving a patent claim term its ordinary and customary meaning has opened the door to discovery by permitting litigants to introduce documents external to the intrinsic evidence and to present extrinsic, battling expert testimony over whether a meaning qualitatively is."ordinary and accustomed" or "special."

In contrast to the above, federal law under § 112 puts the burden on the patentee to give legal meaning to each patent claim term within the patent document as of the time of filing the patent application. Under § 112(a), the patentee is under a duty to give scope to the § 112(b) subject matter of a claim term. In other words, since it is the patentee who is to give property that promotes the useful arts under U.S. CONST. ART. I, § 8, cl. 8, a court is not to give property to the patentee by giving claim terms their ordinary and customary meaning.

Without qualification, it is fair to say that a significant number of infringement cases come down to a dispute over the meaning of a claim term. Simply put, whichever party's definition of that claim term at issue is adopted by the court wins the litigation. Extrinsic evidence has come to play too great a role in this area. To diminish the role extrinsic evidence plays in patent claim construction, Amicus proposes the following heuristic technique.

C. The Role of Intrinsic and Extrinsic Evidence in Patent Claim Construction

In regards to the disputed claim term, the court first is to ask whether an element of the alleged infringer's product or process falls within or without the § 112(a) scope of the § 112(b) subject matter of the disputed claim term. This is similar to determining whether an individual is in or outside of a swimming pool. The individual will be surrounded by water if in the pool and surrounded by dry air if outside of the pool. Thus, it is not necessary to determine where the boundary of the pool is in determining whether an individual is in or outside of a swimming pool. Similarly, it is not necessary to determine where the boundary of the claim term scope is in determining whether an element of the alleged infringer's

product or process falls within or without the § 112(a) scope of the § 112(b) subject matter of the disputed claim term.

Next, in the context of an element of the alleged infringer's product or process, the court may assume a linguistic meaning for the patent claim term at issue whose scope would include the practiced element of the alleged infringer.[6] To aid the court in developing this linguistic meaning, intrinsic or extrinsic evidence may be used.

In view of this linguistic meaning of a patent claim term, the court will determine whether the patentee elevated this linguistic meaning to a legal meaning of the patent claim term at issue. To make this determination, the court may only use the intrinsic evidence in its analysis. In other words, the court may only support its conclusion in an issued opinion with intrinsic evidence. Thus, the analysis set out in the issued opinion is not to be supported by extrinsic evidence, including expert testimony, dictionary definitions, and learned treatises.

D. The Role of § 132(a) Prosecution History as Intrinsic Evidence

As asserted above, the § 112(a) scope of an issued claim term is at its maximum on the filing date of its associated patent application. Thus, statements made during prosecution by the patentee either maintain the original scope, reduce the original scope, or have no effect on the original of an issued claim term. Statements made during prosecution cannot enlarge the scope of an issued claim. The chronological order of the prosecution history statements play a part in each statement's effect on the § 112(a) scope of an issued claim.

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[6] It thus becomes irrelevant as to whether the claim term meaning qualitatively is an "ordinary and accustomed" meaning or is a "special" meaning.

E. § 132(a) Prosecution History Estoppel

The § 112(a) scope of the § 112(b) subject matter of a claim term is at its broadest at the time the application is filed. During the prosecution of a patent, the actions of the patentee may reduce the § 112(a) scope of a claim term from that which the patentee originally gave at the time of filing. Under this view, § 132(a) prosecution history estoppel operates as a prima facie defense to patent infringement of the issued claims by reducing the claim scope prior to issue. Here, § 132(a) prosecution history estoppel operates to prevent a finding of patent infringement rather than a justification or excuse for patent infringement.

One of the main tasks now faced by this Court is a decision as to which actions by the patentee will reduce this scope. To aid in this, the above overview of patent claim construction permits development of figures to represent some of the possible choices in this regard.

Figure 1, reproduced below, illustrates a range of equivalents that is available when there is no claim amendment to create § 132(a) prosecution history estoppel. Accused infringer elements A, B, C, D, and E fall within the § 112(a) scope of the § 112(b) claimed subject matter and accused infringer element F falls without § 112(a) scope.

Like a bite from an apple, Figure 2 illustrates a complete bar to the localized range of equivalents available when a claim amendment creates § 132(a) prosecution history estoppel as proposed by the lower court. *See Festo*, 234 F.3d at 569. Here, accused infringer elements C and D would no longer be within the § 112(a) scope of the § 112(b) claimed subject matter due to § 132(a) estoppel. However, the doctrine of equivalents under § 112(a) would still capture the accused infringer element E.

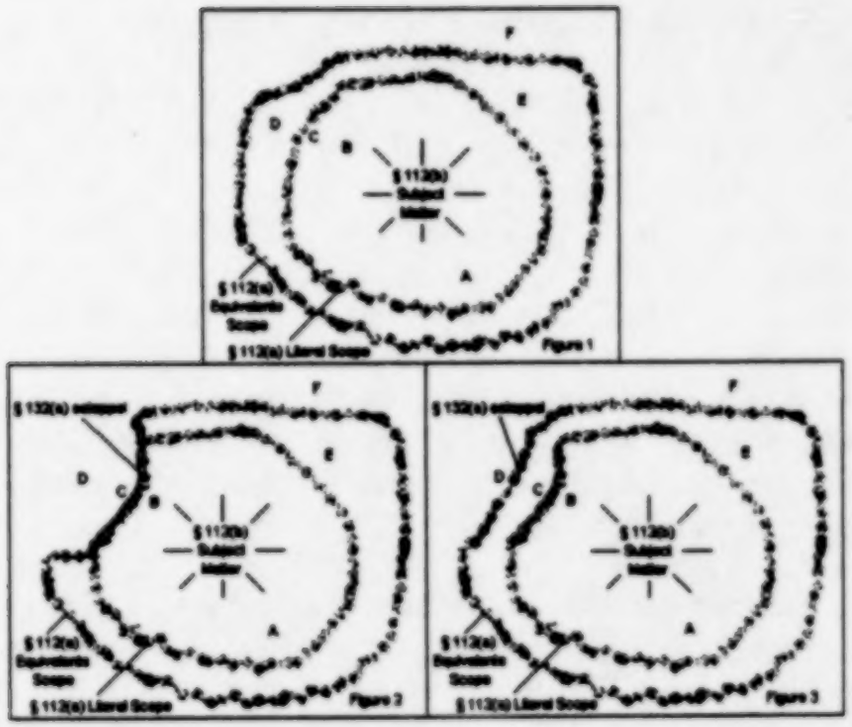


Figure 3 illustrates a flexible bar approach to the localized range of equivalents that is available when a claim amendment creates § 132(a) prosecution history estoppel. Here, the doctrine of equivalents under § 112(a) would capture the accused infringer element E. Moreover, the patent holder would still be entitled to the doctrine of equivalents to the extent the patent holder did not give up subject matter scope in exchange for a patent grant. Under this approach, accused infringer element C would be within the § 112(a) scope through the § 112(a) doctrine of equivalents (unlike in Figure 2). Accused infringer element D would fall outside of the § 112(a) scope due to § 132(a) estoppel, however.

As seen in Figure 2 and Figure 3, § 132(a) prosecution history estoppel only affects a localized area of the § 112(a) scope of the § 112(b) subject matter of a claim term. Thus, a

range of equivalents still is available for the § 112(a) scope of the § 112(b) subject matter of a claim term to capture the accused infringer element E, even under the Figure 2 complete bar proposed by the lower court.

1. Amicus Proposed Holding for the Court

In the absence of a reason for a claim amendment required by the PTO under 35 U.S.C. §§ 102, 103 during patent prosecution, the burden is on the patent holder to establish a reason for the claim amendment by a preponderance of the evidence at the time of issue. In the absence of a reason for a claim amendment not required by the PTO under 35 U.S.C. §§ 102, 103 during patent prosecution, the burden is on the alleged infringer to establish a reason for the claim amendment by a preponderance of the evidence at the time of infringement.

Intrinsic evidence is limited to the § 154 patent document and to the § 132(a) prosecution history and logical inferences that may be drawn from these documents. Extrinsic evidence is evidence that is external to the § 154 patent document and the § 132(a) prosecution history. The evidence an alleged infringer or a patentee may use to meet their burden is restricted to the intrinsic evidence. *Festo*, 234 F.3d at 586 n.6. Neither party may submit nor may the court receive extrinsic evidence such as dictionary definitions, expert testimony, or evidence produced by discovery to meet their burden.

The court then would decide whether a reason for the claim amendment at issue is established by a preponderance of the evidence. The reason for the claim amendment at issue must be related directly to the patentee giving up § 112(a) scope of the § 112(b) subject matter in response to the requirements under either § 102 or § 103 and in exchange for a patent grant.

Where a reason is established by a preponderance of the evidence, the court then would decide whether that reason justifies applying § 132(a) prosecution history estoppel. Where two or more reasons for the amendment are established by a preponderance of the evidence, the court would then decide which reason is the predominant reason for the amendment. The court then would decide whether that predominant reason justifies applying § 132(a) prosecution history estoppel. Each burden described above is subject to shifting if a reason is established by a preponderance of the evidence.

Where no reason is established by a preponderance of the evidence, the court should hold, as the case may be, that § 132(a) prosecution history estoppel applies since the patent applicant had a substantial reason related to patentability for varying the claim term by claim amendment required under § 102 or § 103 or that § 132(a) prosecution history estoppel does not apply since the patent applicant did not have a substantial reason related to patentability for varying the claim term by claim amendment required under § 102 or § 103.

In applying § 132(a) prosecution history estoppel, § 132(a) prosecution history estoppel is to be applied to the § 112(a) scope of the § 112(b) subject matter of the claim term varied by the claim amendment at issue. Moreover, § 132(a) prosecution history estoppel will operate as a complete bar to the localized range of § 112(a) equivalents scope as to that claim term in the context of determining whether an accused element falls within or without the § 112(a) scope of the § 112(b) subject matter of a disputed claim term.

The above described § 132(a) prosecution history estoppel gives proper deference to the role of the § 154 patent document and § 132(a) prosecution history in both

establishing the property rights of a patent holder and in providing public notice. Moreover, proper deference is given to the primacy of the PTO in ensuring that the claims allowed cover only the § 112(b) subject matter that is properly patentable in a proffered patent application. Applied in this fashion, § 132(a) prosecution history estoppel places § 112(a) doctrine of equivalents within the structure of the Patent Act and places reasonable limits on the doctrine.

2. Application of Above Holding to Stoll Claim 1

In a Response to the first Office Action, Festo/Stoll voluntarily amended the claims by rewriting claim 8/1 as issued claim 1 so as to include the limitation "wherein said driven member includes a cylindrical sleeve made of a magnetizable material" in issued claim 1. If the Stoll patent employed the term "the driven member" as a substitute for or a subset of the term "a driven assembly", then the rewriting of claim 8/1 as issued claim 1 would have narrowed the § 112(a) scope of the prior § 112(b) claim 1 term "a driven assembly." In the same Response, Festo/Stoll also voluntarily made two German patents of record. *Festo*, 234 F.3d at 583.

Given the above facts and assuming that the Festo/Stoll Response narrowed the § 112(a) scope of the prior § 112(b) claim 1 term "a driven assembly," it is possible that Festo/Stoll narrowed the prior § 112(b) claim term "a driven assembly" in view of the two German patents or other prior art of record at issue to preempt a § 102 or § 103 rejection and in exchange for the immediately following patent grant. If accused infringer SMC can establish that the predominant reason for the above Festo/Stoll amendment was related directly to Festo/Stoll giving up § 112(a) scope of the prior § 112(b) claim term "a driven assembly" in response to the requirements under either § 102 or § 103 in view of the prior

art of record at issue and in exchange for a patent grant, then the lower court should find that the amendment gives rise to § 132(a) prosecution history estoppel regarding the limitation "wherein said driven member includes a cylindrical sleeve made of a magnetizable material." Amicus proposes that the Court reverse and remand based on the above.

3. Application of Above Holding to Carroll Claim 9

Since it is each individual § 112(b) subject matter that has a § 112(a) scope and not the entire original claim, the lower court's statement that "the amendment narrowed the scope of the original claim," *Festo*, 234 F.3d at 589, is in error. Arguably, the Festo/Carroll amendment indirectly narrowed the § 112(a) scope of the prior § 112(b) claim term "a device." However, a more direct analysis asks whether Festo/Carroll narrowed the § 112(a) scope of the prior § 112(b) claim term "means for controlling." Since the lower court opinion neither address the § 112(a) doctrine of equivalents scope of "means for controlling" to determine whether the amendment narrowed the limitation "means for controlling," *see Id.*, nor the above § 132(a) prosecution history estoppel rule, Amicus proposes that the Court reverse and remand.

II. CONCLUSION

For the reasons stated, the judgment of the Court of Appeals for the Federal Circuit should be reversed.

Respectfully submitted,

VINCENT P. TASSINARI
Counsel of Record
3232 N. Halsted St., #D908
Chicago, IL 60657-3476
(773) 472-0316